UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,065	01/15/2002	Anna Ostberg	290630 110072601US/UDO/SU	1088

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PILLSBURY WINTHROP SHAW PITTMAN, LLP Eric S. Cherry - Docketing Supervisor P.O. BOX 10500 MCLEAN, VA 22102	MEUCCI, MICHAEL D

ART UNIT	PAPER NUMBER
2142	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

mr (handwritten)

	Application No.	Applicant(s)
Office Action Summary	10/050,065	OSTBERG ET AL.
	Examiner	Art Unit	
	Michael D. Meucci	2142	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 Marcy 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-5,7,8,11 and 12</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,3-5,7,8,11 and 12</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 May 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is in response to the Request for Continued Examination (RCE) filed

19 March 2007.

2.   Claims 1, 3-5, 7, 8, 11, and 12 are currently pending.

Priority

3.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(b), which

papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 1, 3, 4, 5, 7, 8, 11, and 12 are rejected under 35 U.S.C. 112, first

paragraph, as failing to comply with the written description requirement. The claim(s)

contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. The applicant's claim

terminology utilizing "means for" render the claims indefinite since the specification

provides no insight as to what these means may include. The applicant's specification

is little more than a rehashing of claim terminology that fails to provide any structural

basis to the system. Incidences of this terminology include but are not limited to:

"database means," "means connected to or comprised in the top level domain server for

identifying a calling party," and "means connected to or comprised in the top level

domain server for blocking an unidentified calling party."

6.   Claims 4 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. It is unclear to the examiner how a level of

blocking is capable of providing micro debiting. This is limitation is not described in the

specification in any manner. For the purpose of applying art, it will be presumed that

any providing of micro debiting will occur at the debiting server.

7.   Claims 4 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. It is unclear to the examiner how an

accumulated micro debiting can be partitioned as disclosed in the claims. The applicant

appears to be invoking 35 U.S.C. 112, sixth paragraph by using "means for"

terminology, but does not provide any description in the specification as to how this

occurs. For the purpose of applying art, it will be presumed by the examiner that a

micro payment will be made to at least one of the top level domain and a registered

service provider.

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

9.   The claims appear to be a literal translation into English from a foreign document

and are replete with grammatical and idiomatic errors. The examiner suggests rewriting

claims in proper English to avoid improper interpretation.

10.   Claims 1, 3-5, 7, 8, 11, and 12 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

        a.   Claims 1 and 5 recite the limitation "said first level of blocking." There is

insufficient antecedent basis for this limitation in the claim. Exemplary claim 1 states: "a

first level of blocking unwanted communication, said first level of blocking..." The

statement "a first level of blocking unwanted communications" does not antecede "a first

level of blocking." As such, the limitation is indefinite. Correction is required.

        b.   Claim 1 recites the limitation "second level of blocking providing micro

debiting..." It is unclear to the examiner what is being blocked and how it is being

blocked. For the purpose of examination, the examiner presumes that --unwanted

traffic-- is being blocked in the same manner as the first level of blocking.

        c.   Claims 11 and 12 recite the limitation "means in the debiting server for

percentage partitions in at least two entries of accumulated micro debitings for every

session during login, which entries are credited to at least one of the top level domain

and a registered service provider." The claims in their entirety are unclear. Because

the examiner is unable to determine what is meant to be disclosed by these limitations,

a general art rejection has been issued. Amendment to and clarification of the claims is

required.

d.   Claims 1, 3, 4, 5, 7, 8, 11, and 12 improperly recite "means for"

terminology including "means connected to or comprised in the top level domain server

for identifying a calling party during..." (claim 1), "means for partitioning..." (claims 3 and

4), "connecting database means to the top level domain server for registering..." (claim

5), and "means in the debiting server for percentage partitions..." (claims 11 and 12).

The applicant's appears to be trying to use a "means" clause to recite a claim element

as a means for performing a specified function. However, since no function is specified

by the word(s) preceding "means," it is impossible to determine the equivalents of the

element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159

USPQ 694 (Bd. App. 1967). The applicant's specification provides no additional insight

as to what each of these claimed "means" may include and are therefore considered

indefinite.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 1, 3-5, 7, 8, 11, and 12 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Gardos et al (U.S. 6,880,007) hereinafter referred to as Gardos, in

view of Peled et al. (U.S. 2002/0016831) hereinafter referred to as Peled, Sheth et al.

(U.S. 6,874,030) hereinafter Sheth, and Ling (U.S. 7,177,838 B1).

13.   Regarding claims 1 and 5 Gardos teaches: a first level of blocking unwanted

communication, said first level of blocking being in the form of a top level domain

requiring registration for web sites residing within the domain, whereby registered

websites are approved after examination within stated criteria for said top level domain

(col.. 1 lines 45-65, col.. 2 lines 1-4, col.. 4 lines 3-7, and Fig 7); at least one top level

domain server for connection to the top level domain (col. 2, lines 5-15), domain server

having files and software (col. 2, lines 10-15); database means connected to the top

level domain server for registering and approving of a service provider residing within

the top level domain (line 65 of column 1 through line 3 of column 2).

        Gardos does not explicitly teach: means connected to or comprised in the top

level domain server for identifying a calling party during login to the top level domain.

However, Peled discloses: "Connections via the Internet or any other global electronic

network, may thus be assisted by the availability of authentic data concerning the

identity of the potential user and/or consumer requesting electronic goods," (paragraph

[0003] on page 1).

        Gardos does not explicitly teach: a second level of blocking providing micro

debiting through a debiting server during connection to the top level domain, the second

level of blocking including means for debiting of the top level domain via micro debiting

and means for accumulating said micro debiting during every session a user is

connected to said domain. However, Peled discloses: "That is to say the ISP's may

debit the distributor, so that connecting to a user through several ISPs in order to

download media content may render the transaction uneconomical for the distributor,"

(paragraph [0011] on page 1 of Peled).

Gardos does not explicitly teach of blocking an unidentified calling party.

However, Sheth teaches of blocking an unidentified calling party (col. 3, lines 53-36)

and whereby registration of those connected to the domain and the identification of a

calling party prevents a free connection and anonymity in computer networks through

said top level domain server (16), which accomplishes a top level domain purged from

unwanted network traffic (col. 2, lines 35-42). It would have been obvious to one of

ordinary skill in the art at the time of invention to incorporate the teachings of Sheth and

Peled because the inventions relate to communication via the Internet. One of ordinary

skill in the art at the time of invention would have been motivated to make the above-

mentioned modifications because it would have resulted in a more secure

communication system by preventing unauthorized access to system resources. This is

desirable as discussed by Peled (Paragraph [0021]).

While Peled does teach debiting (as described above) in general, Peled and

Gardos do not explicitly teach micro debiting. However, Ling discloses: "Additionally,

some software rentals may have a very low cost. For example, renting a single page

use of a translation package may cost less than the typical fees associated with

processing credit card transactions. Such "micropayment" transactions, sometimes amounting to only fractions of a cent, may also occur in the context of providing access to media, or Web-based services, such as search engines," (lines 24-30 of column 2). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to use micro debiting. "In each of these cases, it is necessary to provide a way for users to pay for such transactions without incurring the overhead of a credit card charge," (lines 30-33 of column 2 in Ling). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to use micro debiting in the system as taught by Gardos. Additionally, the applicant admits that micro debiting is well known in the art (see paragraph 4, page 7 of applicant's remarks filed 19 March 2007 and submitted articles "PayWord" and "MicroMint").

One of ordinary skill in the art at the time of invention would have been motivated to make the above-mentioned modifications because it would have resulted in a more secure communication system by preventing unauthorized access to system resources. This is desirable as discussed by Peled (Paragraph [0021]).

14.   Regarding claim 3 and 7, Gardos teaches: the web address of the one connected is stored for debiting in a database (col. 2, lines 20-25).

15.   Regarding claim 4, Gardos teaches: means for partitioning an accumulated micro

debiting into at least two entries for every session during login, where the entries are

credited to at least one of the top level domain and a registered service provider (Fig.

7).

16.   Regarding claim 8, Gardos teaches: wherein the micro debiting includes

partitioning an accumulated micro debiting into at least two entries for every session

during login, wherein the entries are credited to at least one of the top level domain and

a registered service provider (Fig 7).

17.   Regarding claims 11 and 12, Gardos does not explicitly teach: means in the

debiting server for percentage partitions in at least two entries of accumulated micro

debitings for every session during login, which entries are credited to at least one of the

top level domain and a registered service provider. However, Ling discloses:

"Additionally, some software rentals may have a very low cost. For example, renting a

single page use of a translation package may cost less than the typical fees associated

with processing credit card transactions. Such "micropayment" transactions, sometimes

amounting to only fractions of a cent, may also occur in the context of providing access

to media, or Web-based services, such as search engines," (lines 24-30 of column 2). It

would have been obvious to one of ordinary skill in the art at the time of the applicant's

invention to use micro debiting. "In each of these cases, it is necessary to provide a

way for users to pay for such transactions without incurring the overhead of a credit

card charge," (lines 30-33 of column 2 in Ling). It is for this reason that one of ordinary

skill in the art at the time of the applicant's invention would have been motivated to use

micro debiting in the system as taught by Gardos.

Response to Arguments

18.   Applicant's arguments with respect to claims 1, 3-5, 7, 8, 11, and 12 have been

considered but are moot in view of the new ground(s) of rejection.

Conclusion

19.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael Meucci at (571) 272-3892. The examiner can

normally be reached on Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Caldwell, can be reached at (571) 272-3868. The fax phone

number for this Group is 571-273-8300.

Communications via Internet e-mail regarding this application, other than those

under 35 U.S.C. 132 or which otherwise require a signature, may be used by the

applicant and should be addressed to [michael.meucci@uspto.gov].

All Internet e-mail communications will be made of record in the application file.

PTO employees do not engage in Internet communications where there exists a

possibility that sensitive information could be identified or exchanged unless the record

includes a properly signed express waiver of the confidentiality requirements of 35

U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published

in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG

89.

Information regarding the status of an application may be obtained from the

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more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER